

Application No.: 09/801,929  
Amendment dated March 23, 2006  
Reply to Office Action of December 23, 2005

### **REMARKS**

The non-final office action of December 23, 2005 (hereinafter the Action) has been carefully reviewed and these remarks are responsive thereto. Claims 1, 4-7, 9, 25, 26, and 28-47 are pending. By this amendment, claims 1, 5, 29 and 30 are amended. Claims 1, 4-7, 9, 25, 26, and 28-47 are rejected. Claims 5 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,018,336 to Akiyama *et al.* ("Akiyama"). Claims 1, 4, 7, 9, 25, 26, 28, 29, 31-38, and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of U.S. Patent No. 5,000,935 to Moran *et al.* ("Moran"). Claims 30 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Moran in further view of U.S. Patent No. 5,625,833 to Levine *et al.* ("Levine"). Reconsideration and allowance of the instant application are respectfully requested in view of the amendments and arguments made herein.

### **Objections to the Claims**

The Action noted several informalities in claims 1, 5 and 30. Applicants appreciate the careful review of the claims and have amended claims 1, 5 and 30 in a manner that is believed to address the informalities noted.

### **Amendment to the Claims**

Claims 1, 5, 28-30 have been amended to clarify and more distinctly point out the intended scope of the claimed subject matter. No new matter has been added.

### **Rejection under 35 U.S.C. § 112, ¶ 1**

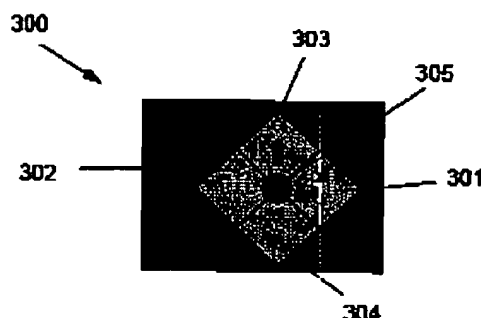
Claims 1, 4-7, 9, 25, 26 and 28-47 were rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement. In particular, the Action suggested that the rejected claims recite subject matter that was not described in the specification in such a way as to convey to one of reasonable skill in the art that the inventors had possession of the invention at the time of filing.

Looking at claim 1, Applicants note that recited feature of "responsive to determining that the stylus input is preceded by the predetermined gesture, displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting

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of a shift function, a control function, and an alternate function" as found in claim 1 is disclosed in the specification as filed. Figure 3 of the application as filed is provided below:



**FIG. 3**

As the specification as filed explains on page 7, Figure 3 is an exemplary user interface. In addition, the specification as filed on pages 14-15 explains that:

Figure 3 shows an exemplary UI element 300 that is displayed when a down spike in-air gesture is detected. Figure 3 shows that the selections contained in UI element 300 displayed with a down spike in-air gesture are detected include RIGHT 301, CTL 302, SHIFT 303, ALT 304 and BULL'S-EYE 305.

Thus, a person of ordinary skill would plainly be able to discern that the feature: "responsive to determining that the stylus input is preceded by the predetermined gesture, displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting of a shift function, a control function, and an alternate function" as recited in claim 1 was described in the specification in such a way as to convey that the Applicants had possession of the claimed subject matter at the time of filing.

Claim 5 recites "displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting of a shift function, a control function, and an alternate function." As noted above, Figure 3 depicts an exemplary user interface with selectable functions include a shift, control and alternate function. In view of Figure 3 and the associated detailed description in the specification as filed on pages 14-15, Applicants respectfully submit that the claimed subject matter that includes the feature

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“displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting of a shift function, a control function, and an alternate function” as recited in claim 5 plainly was in Applicants’ possession at the time of filing.

Regarding the feature of “responsive to a second stylus input, sending a mouse button event modified in accordance with the user-selected keyboard function” as recited in claim 32, support for this feature is found in the specification and drawings as filed. For example, pages 15-16 of the specification as filed explain that “when shift 303 is selected, a SHIFT key accompanies the next pen touch.” The specification as filed on page 15 further explains that:

CTL 302, SHIFT 303 and ALT 304 are additional instances of the corresponding modifier buttons on a keyboard. Consequently, CTL 302, SHIFT 303 and ALT 304 are displayed as activated or locked when a corresponding instance is in either state. As soon as UI element 300 becomes visible, an inactivity timer is started. When a user does not tap the pen anywhere within UI element 303 before the inactivity timer expires, UI 300 hides, or disappears from view. Preferably, the duration of the inactivity timer is about 3 seconds. When a user taps the pen tip in the BULL’S-EYE 305, and none of CTL 302, SHIFT 302 and ALT 304 is active, UI 300 sends a right button click event to the window immediately below BULL’S-EYE 305. UI 300 then disappears from view. When one or more of the modifiers CTL 302, SHIFT 303 and ALT 304 is active and a user taps in the pen tip within BULL’S-EYE 305, UI 300 sends a right click event plus the modifier(s) to the window immediately below BULL’S-EYE 305.

Applicants respectfully submit that the above section more than adequately conveys that the Applicants were in possession of the claimed subject matter at the time of filing.

Regarding claims 29-30, the specification as filed on pages 13-14 discloses that “[w]hen the pen touch is preceded by a selected in-air gesture, no “left button down” event is sent. Instead, the UI is displayed preferably near the pen tip.” Applicants respectfully assert that in light of this and the above disclosure, the features of claims 29 and 30 are more than adequately described in the specification as filed so as to indicate to persons of ordinary skill that Applicants were in possession of the claimed subject matter at the time of filing.

Regarding claim 45, the specification as filed explains on pages 13-14 that “[p]referably, the default event that is sent to an application when the pen touches the writing surface is a “left button down” event. When the pen touch is preceded by a selected in-air gesture, no “left button

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down" event is sent." Thus, the subject matter of claim 45 was adequately described in the specification as filed and was plainly in Applicants' possession at the time of filing.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 112, ¶ 2**

Claims 28-30 and 41 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to distinctly point out and claim the subject matter regard as the invention. In response, claims 28-30 have been amended to clarify their intended subject matter.

Regarding claim 41, Applicants believe that claim 41 as currently pending is definite. Claim 41 depends from claim 32 and adds the additional feature of "sending the mouse button event ... to a running application." As is known, computer applications can accept inputs and may be programmed so as to reach a state where an input is needed. The application will then wait until receipt of such an input and at the point the application will perform whatever tasks are associated with the input. Therefore, as the general concept of providing inputs to running applications is believed to be known, no further clarification is believed needed for claim 41.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 102(e) - Akiyama**

Claims 5 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Akiyama. Independent claim 5 recites "displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting of a shift function, a control function, and an alternate function." The Office Action has pointed to no place in Akiyama that discloses such a feature. Indeed, the Action admits that Akiyama does not explicitly teach the selectable functions (see Office Action of December 23, 2005, page 9). Akiyama merely discloses a bar that has a move, a right click and a help function. As Akiyama plainly fails to disclose the recited functionality, Akiyama fails to disclose the above recited step and therefore fails to disclose all the limitations of claim 5. As Akiyama does not disclose all the limitations of claim 5, Akiyama cannot be said to anticipate claim 5.

Claim 6 depends from claim 5 and is not anticipated for the reasons discussed above and for the additional limitations recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

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**Rejection under 35 U.S.C. § 103(a) – Akiyama & Moran**

Claims 1, 4, 7, 9, 25, 26, 28, 29, 31-38, and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Moran. Claims 1 and 32 are independent.

Regarding independent claim 1, for reasons similar to the reasons discussed above with respect to claim 5, Akiyama fails to disclose the feature of “displaying a user interface having a plurality of selectable functions including at least one function selected from the list consisting of a shift function, a control function, and an alternate function.” The Action has not suggested that Moran corrects this deficiency, nor does Moran appear capable of doing so.

The Action admits that Akiyama does not disclose such a feature but suggests that Akiyama teaches or suggests these functions when Akiyama states that “other mouse functions can be emulated by increasing the selection button of the other mouse functions.” Applicants respectfully submit while the meaning of this sentence is, at best, ambiguous, the Action has provided no support for its suggestion that alternate, control and shift functions were commonly considered “other mouse functions” at the time of filing. Indeed, Applicants respectfully assert that such an interpretation would not be supported today, let alone at the time of filing of the instant application. Furthermore, Akiyama fails to disclose or suggest anything that would provide any support for such an interpretation and therefore, it appears that the Action is using the present application as a roadmap to modify the cited references. Such hindsight reconstruction is improper and unwarranted in this case. Rather, the combination of Akiyama and Moran fails to disclose all the features of independent claim 1. As the combination of Akiyama and Moran fail to disclose all the features of claim 1, the combination fails to support a prima facie case of obviousness.

Claims 4, 7, 9, 25, 26, 28, 29, 31, 45 and 46 depend from independent claim 1 and are nonobvious for at least the reasons support claim 1 and for the additional limitations recited therein.

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Independent claim 32 recites the features of "determining whether the first stylus input is preceded by a particular gesture" and "responsive to determining that the first stylus input is preceded by the particular gesture, displaying a graphical user interface including a user-selectable keyboard function." The Action admits that Akiyama fails to disclose the stylus input preceded by a predetermined gesture, thus Akiyama necessarily cannot disclose these steps. Looking at Moran, Applicants have been unable to locate any mention of such steps. Therefore, the combination of Akiyama and Moran fails to disclose, suggest or teach all the features of claim 32 and cannot be said to support a *prima facie* case of obviousness.

Regarding the Actions suggestion that Akiyama can somehow be modified in view of the teaching of Moran even though Moran does not disclose such a step, Applicants respectfully submit such a rejection is improper. All limitations must be disclosed in a cited reference or be otherwise well known in the art. The Action has not suggested the recited steps of claim 32 were well known in the art at the time of filing, nor do the references of record support such a statement. Therefore, the present rejection fails to provide the support required of a *prima facie* case of obviousness. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations."). In addition, Moran at most can be read to suggest that use of gestures was known at the time of filing. However, this in no way suggests, discloses, or teaches the features recited in claim 32. Therefore, for at least the above reasons, the combination of Akiyama and Moran fails to disclose the all the limitations of claim 32 and therefore cannot be said to support a *prima facie* case of obviousness with respect to claim 32. As the combination of Akiyama and Moran does not support a *prima facie* case of obviousness, claim 32 is nonobvious over the combination.

Claims 33-38, 40-44 and 47 depend from claim 32 and are nonobvious over the combination of Akiyama and Moran for at least the reasons discussed above with respect to claim 32 and for the additional features recited therein.

In addition, Applicants respectfully disagree with the Action's suggest that Office Notice may be taken of the features recited in claim 4 and 40. The MPEP explains that:

It would not be appropriate for the examiner to take office notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For

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example, assertions of technical facts in areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

MPEP 2133.03(A) (August 2005 Ed.)(emphasis in original). Here, the recited features are technical details of the type that, if the Examiner feels are known, should be supported by citation to some reference recognized as a standard. Otherwise, this reason is unsupported and cannot be maintained. Applicants respectfully request that the Examiner provide the appropriate support or withdrawal this reason for rejecting claims 4 and 40.

Accordingly, for at least the above reasons, withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 103(a) – Akiyama & Moran and Levine**

Claims 30 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Moran in further view of Levine. Claim 30 depends from claim 1 and claim 39 depends from claim 32. The Action has not suggested that Levine corrects the above noted deficiencies in Akiyama and Moran corresponding to claims 1 and 32. Nor, after further review, does Levine provide support for such a suggestion. Thus, the combination of Akiyama, Moran and Levine fails to support a prima facie case of obviousness with respect to claims 30 and 39 for at least the reasons discussed above with respect to claims 1 and 32 and for the additional limitations recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

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**CONCLUSION**

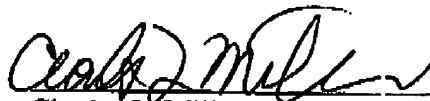
All rejections having been addressed, Applicants submit that the instant application is in condition for allowance, and respectfully request prompt notification of the same. Should the Examiner feel that a telephone call would expedite prosecution, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: March 23, 2006

By:



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